

## **REMARKS**

The office action and the patents that were cited and applied have been carefully considered together with the present application and amendments have been made to the independent claims 1 and 10 to more clearly define the present invention and to further emphasize the differences between the present invention and the prior art that has been cited and applied by the examiner.

The examiner has objected to the drawings for the stated reason that the light touch switch being located substantially within the housing as set forth in claims 1 and 10 must be shown or the features canceled from the claim. Applicants respectfully traverse this objection. It is clear from the specification as well as the drawings that these claim recitations are supported by the specification and are in fact shown in Figs. 1, 2 and 4. Fig. 4 shows a perspective view of the switch 30 which clearly illustrates that it has a housing 32, a movable switch element 34, and contact legs 36, all of which comprise a 3-dimensional structure which is also identified in Figs. 1, 2 and 3 by the reference number 30.

Moreover at page 5, lines 21-25, the specification states that the nose portion 12 of the tool accordingly includes a correspondingly sized and configured recess for receiving the light touch switch 30. The recess is configured so that the light touch 30 fits within the recess in a manner whereby the top surface of the switch element 34 is generally coextensive with the top surface of the nose portion 12. It is clear from the specification and drawings that the light switch is located substantially within the housing

and the switch is part of a tool. The objection to the drawings is wholly unfounded, if not specious and should be withdrawn. Applicants respectfully request that it be withdrawn.

The examiner has also rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, essentially for the same reasons. As described above with regard to the specification and the drawings, there is no doubt whatsoever that the written description requirement has been complied with and that this rejection also is baseless and should be withdrawn.

The examiner's contention that the usage in the specification that the light touch switch 30 is disposed *on* a portion of the nose portion establishes that it is "not located substantially within the housing" is contradicted by the above-referenced discussion at page 5, lines 21-25. Also, the specification includes the further discussion provided at page 5, lines 11-20 wherein it is stated that the electrical contact legs 36 extend from a bottom surface of the housing 32. The tapered nose portion 12 of the tool has a limited surface area and volume to accommodate electrical components. Therefore, the size of the light touch switch 30 is preferably minimized to consume the least amount of surface area and depth, while being large enough to impart tactile qualities to the switch to enhance ease of operation of the switch. In the preferred embodiment, the housing 32 has a length of approximately 6.0 mm, a width of approximately 3.5 mm, and a depth of approximately 3.5 mm, exclusive of the depth added by the contacts 36. The switch element 34 preferably has a length of approximately 3.0 mm, and a width of approximately 1.4 mm.

The examiner's focus on the use of the terminology *on* rather than *in* ignores the reality of the totality of the description of the structure of the switch and its relation with the housing as set forth in the specification, including the portions specifically set out above.

The examiner has again rejected claims 1, 3-5, 10 and 12 under 35 U.S.C. 102(b) as being anticipated by Sjostrom and has rejected the other dependent claims under 35 U.S.C. § 103(a) as being unpatentable over Sjostrom in view of Markle or van Hollen. With respect to claims 1 and 10, it is believed that Sjostrom fails to anticipate, teach or suggest these claims. Claim 1 is now directed to a control mechanism for a rotary hand tool having a generally cylindrical housing in which a drive motor is located, the housing having a generally tapered nose portion at an end from which a motor shaft extends and includes, *inter alia*, an electrical control circuit contained within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to the motor, as well as the recitation that the switch is disposed on the tapered nose portion of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

The examiner's attempt to describe Sjostrom as meeting the elements of this claim includes the statement that Sjostrom has an electrical control circuit, identified as reference number 145, that controls the application of power to and the operation of the motor (with processor 215) including supplying current to the motor. This is an unacceptable and improper distortion of the structure and operation of Sjostrom. Sjostrom clearly does not have an electrical control circuit contained entirely within said

housing inasmuch as Sjostrom clearly illustrates and describes a multiple component structure wherein a console 205 is interconnected by a cable 145 to the separate handpiece 100. It is a total distortion to contend that a cord 145 and microprocessor 215 comprises an electrical control circuit that is contained entirely within a housing. A cord cannot be a control circuit, and there is no single housing that contains such electrical circuitry. Sjostrom has a handpiece with electrical circuitry as well as a separate console that has its own housing and contains the microprocessor and other control circuitry. Moreover, Sjostrom does not have a light touch switch that is disposed on the tapered nose portion of the rotary hand tool as is claimed in claim 1 for the reason that the only switches for the motor are Sjostrom's pushbutton switches 125, 130 and 135, which are on the cylindrical hand piece rather than on a tapered nose portion. Therefore, Sjostrom cannot anticipate, teach or suggest this claim, and reconsideration and allowance of it is respectfully requested.

Claim 10 has been amended to recite apparatus for selectively controlling power applied to and the operator of the motor of a rotary hand tool having a generally cylindrical housing that includes a generally tapered nose portion that has a gradually reduced circumference toward an end from which an output shaft extends and it comprises, *inter alia*, electrical control circuitry . . . located entirely within the housing as well as a switch as defined in the claim which is also stated to be located substantially within the tapered nose portion thereof and in addition includes a cavity disposed in the tapered nose portion of the tool that is configured to receive at least a portion of said switch and permit actuation of said switch button. Sjostrom simply fails to meet these

elements of the claim. For all of these reasons, it is believed that Sjostrom clearly fails to anticipate, teach or suggest this claim. Reconsideration and allowance is therefore respectfully requested.

With respect to the obviousness rejections, applicant continues to believe that they are improper. There is no motivation for any combination of Sjostrom with either Markle or van Hollen. Sjostrom is unrelated art and is not properly combinable with either of these references. Moreover, there is no motivation supplied by any of these three references to combine them with the other. It defies common sense that such a combination would be made and is contrary to the recent decision of *In re Kahn* from the Court of Appeals for the Federal Circuit.

The dependent claims necessarily incorporate the subject matter of the independent claims from which they depend and in addition add other features and/or functionality that are not found in the independent claims and for this reason the dependent claims are also believed to be in condition for immediate allowance.

Reconsideration and allowance of all claims presenting pending in the application is therefore respectfully requested.

Respectfully submitted,

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